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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 09/749,036 | 12/28/2000 | Veronique Ferrari | 05725.0832-00 | 5474 |
| 22852 7590 01/17/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413 | | | EXAMINER VENKAT, JYOTHSNA A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1615 | |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 01/17/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|---|---------------------------------------|--|
| Office Action Summary | Application No. 09/749,036 | Applicant(s) FERRARI ET AL. | |
| | Examiner JYOTHSNA A. VENKAT Ph. D | Art Unit 1615 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>10/20/06</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are
121,122,124,127,129,131,132,137,143,144,147,157,158,161,170,172,177-180,183,218,219,221,223 and 1666.

Continuation of Disposition of Claims: Claims rejected are
121,122,124,127,129,131,132,137,143,144,147,157,158,161,170,172,177-180,183,218,219,221,223 and 1666.

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/20/06 has been entered.

Receipt is also acknowledged of IDS filed on 10/20/06.

Claims 121-122, 124, 127, 129, 131-132, 137, 143-144, 147, 153, 157-158, 161, 166, 169-170, 172, 177-180, 183, 218-219, 221 and 223 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 121-122, 124, 127, 129, 131-132, 137, 143-144, 147, 153, 157-158, 161, 166, 169-170, 172, 177-180, 183, 218-219, 221 and 223 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 5,783, 657 ('657); 3,148,125 ('125) and 6,214, 329 ('329).

The instant application is claiming

1. Polymer of formula I
2. Pasty fatty substance
3. Oil or non-volatile oil (claims 143-144, and 147)
4. Volatile oil (claim 153)
5. Amphilic compound (claim 172)
6. Coloring agent (claims 178-180)
7. Wax (claim 183)
8. Additives (claim 177)

The patent '657 teaches polymer claimed in the instant application (ingredient 1) having *gel consistency* and these gels are useful in personal care products where in some self-supporting consistency is desired. See the abstract; see cols. 3-4 and see col.3, line 24 where the patent teaches that these polymers are useful in eye-makeup. The eye make up products are Mascara, eye shadow and eyeliner. The patent suggests the usefulness of this polymer in the eye-make up art. *The patent at col.17, lines 25-30 teaches that this polymer can be combined with water, colorants and fillers and also teaches adding volatile solvent.* Patent '125 also teaches the polymer (Versamid) useful as lipsticks. Versamid is species belonging to polyamide resin. Lanolin alcohols and ethoxylated lanolin alcohols belong to claimed past fatty substance or the

specific compound claimed in the Markush group in this category which is “lanolin derivatives” of claim 161, castor oil of patent belong to claimed “oil or apolar oil or non-volatile oil”, PEG esters or Lauryl lactate taught in the patent belong to claimed amphilic compound, dyes of the patent belong to claimed coloring agents, isopropyl alcohol belong to claimed additive which is “water miscible compounds”. The difference between the patents and the instant application is the patents do not teach the volatile solvent or amphilic compound. Patent ‘329 teaches Mascara product using specific volatile oil claimed at col.6, line 60 and at paragraph bridging cols. 8-9 the specific fillers claimed, and at col.9 pigments claimed and under example 1 teaches preservatives which are the parabens. Patent ‘329 teaches waxes at col.5, lines 15-37. The patent teaches the combination of waxes, coloring agents, amphilic compounds, volatile and non volatile oils and using this combination **with compounds functioning as *gelling agents***.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions using the polymer of ‘657 or ‘125 and use it as Mascara or lipstick taught by both the patents along with oils, amphilic compounds, additives, oils, pigments, and use the specific volatile solvents and waxes of ‘329 expecting that the compositions are useful as Mascara or lipstick (cosmetics). The motivation to combine the ingredients flows logically from the art for having been used in the same cosmetic art. One of ordinary skill in the art would be motivated to combine the ingredients with the reasonable expectation of success that the compositions which has the polymer has the structured property and also when this polymer is combined with hydrocarbons (volatile solvent) it becomes transparent. This is prima facie case of obviousness.

Response to Arguments

4. Applicant's arguments filed 10/31/06 have been fully considered but they are not persuasive.

5. Applicant's argue that Office has failed to demonstrate some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify '657 and arrive at the present invention and applicant admit that patent '125 does disclose fatty acid esters and *lanolin alcohols in a laundry list of optional ingredients*, not all fatty acid esters, including several of the compounds listed in '125 as pasty fatty substances as defined by the instant claims and argue that even if one of the numerous compounds listed in '125 is a pasty fatty substance, the Office has not provided any specific motivation for one of ordinary skill in the art to choose any particular compound therein and add it to the compositions of '657.

6. In response to the above argument, patent '657 teaches ester-terminated polyamides in cosmetic formulations. The patent clearly teaches to one of ordinary skill in the art that the combination of the polyamides claimed along with liquid hydrocarbon (claimed as liquid fatty phase) forms clear transparent compositions having a gel consistency. The two properties of gel consistency and clear compositions are useful to the consumer. Patent '125 teaches the combination of polyamide resin, liquid fatty phase (castor oil) and pasty fatty substances (lanolin alcohols or ethoxylated lanolin alcohols) provide **clear lipsticks**. Lanolin alcohol and ethoxylated lanolin alcohols are disclosed in the examples. These compound belong to claimed past fatty substances. Applicant's attention is drawn to page 26 of instant specification, which describes pasty fatty substances. Specification describes "lanolins and lanolin derivatives such

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as acetylated lanolins or oxypropylenated lanolins or isopropyl lanolate “. Lanolin alcohols and ethoxylated lanolin alcohols disclosed in the patent ‘125 belong to lanolin derivatives of claim 161. Applicants attention is also drawn to examples which teaches castor oil (non-volatile oil). Castor oil belongs to liquid fatty phase. Therefore both the patents teach the combination of fatty phase and polyamide resin (whether the genus claimed and disclosed in the patent ‘657 or the species belonging to polyamide resin taught in the patent ‘125). This combination forms crystal clear products. Crystal clear products benefit the consumer since they are attractive.

7. Applicants argue that patent ‘329 does not remedy the deficiencies set forth above, as it actually teaches away from the proposed combination, since patent ‘329 emphasizes throughout the disclosure that the composition includes a "non-polymeric gelling agent" where as the patents ‘657 and ‘125 teach polymeric gelling agent and patent ‘329 clearly teaches against by emphasizing non-polymeric gelling agents.

In response to the above argument, patent ‘329 teaches Mascara product (cosmetic) using specific volatile oil claimed at col.6, line 60 and at paragraph bridging cols. 8-9 the specific fillers claimed, and at col.9 pigments claimed and under example 1 teaches preservatives claimed and teaches waxes at col.5, lines 15-37. Patent ‘329 teaches the combination of waxes, coloring agents, amphiphilic compounds, volatile and non volatile oils and compounds which function as gelling agents. Therefore one of ordinary skill in the cosmetic art would use the specific oil of ‘329 and combine it with the compositions of ‘657 and ‘127 with the reasonable expectation of success that the incorporation of specific volatile oil into the compositions **would not destroy the gel property** since the same specific oil can be used with products having gel consistency.

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Therefore it is immaterial whether the gelling agent is polymeric or non-polymeric since the end result is having compositions with gel property and transparent property.

Applicants also argue that patent '329 explicitly only teaches exclusively the non-polymeric variety of gelling agents, not a mere preference and the Office has not provided any basis for the assertion that it is obvious to include known polymeric gelling agents in the composition of '329 and it is improper for the Office to disregard its explicit teachings.

In response to the above argument, applicant's attention is also drawn to col.11, lines 40-60, where in patent teaches that thickening agents can be added. These include polymeric compounds like cellulose derivatives, dextrans, pullans and gellan. Thickening agents also function as gellants. Therefore patent teaches the additions of polymeric thickeners into the compositions of '329.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

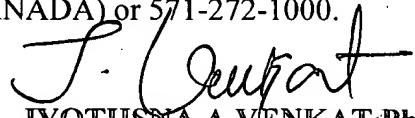
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JYOTHSNA A VENKAT Ph. D
Primary Examiner
Art Unit 1615
